

REMARKS

Amendments to the Claims

By this amendment, Applicant has amended claims 1, 32, 33, 35, 40, 51 and 75 and added claim 86. Claims 4, 5, 26, 28-31, 34, 49-50, 61, 66-67, 71-74, and 76 have been cancelled.

35 U.S.C. §102

The Office Action rejected claims 1-3, 6, 7, 9, 16-20, 22, 24-27, 32, 34, 37-40, 75-78, and 80-84 under 35 U.S.C. §102(e) as being anticipated by Sharkey et al (6,379,350). In view of this amendment, Applicant requests reconsideration and withdrawal of the rejections.

Claims 1 and 75 have been amended to recite that the shaft includes at least one aspiration port coupled to an aspiration lumen and at least one digestion electrode arranged within the aspiration lumen wherein the digestion electrode serves as an active electrode. This claim limitation is not shown in the cited reference. Accordingly, Applicants request withdrawal of the rejections of these claims.

The remainder of the claims rejected under § 102 depend from claims 1 and 75 or a claim depending thereon. Accordingly, it is submitted that the dependent claims are also allowable over the cited reference.

35 U.S.C. §103

Claims 8, 10-14, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharkey et al. (6,379,350). Additionally, the Office Action rejected claims 15, 51-60, 62-65, 68-70, and 85 under 35 U.S.C. §103(a) as being unpatentable over Sharkey et al. in view of Baker (5,785,705.)

As discussed above, applicant amended independent claims 1 and 75 to recite that at least one digestion electrode is arranged within the aspiration lumen of the shaft wherein the digestion electrode serves as an active electrode. This claim limitation is not described or suggested in the cited references.

With respect to claim 51, it now recites the subject matter of claim 61 which the Office Action has indicated is allowable.

Accordingly, no combination of the cited references teach or suggest all claim limitations, a requirement of a *prima facie* case of obviousness. See MPEP § 2143.

The other claims rejected under §103(a) depend from claims 1, 51, or 75. Accordingly, it is submitted that the dependent claims are patentable over the cited references.

In view of the above, applicant respectfully requests withdrawal of the rejections under §103(a).

Allowable Subject Matter

Applicant's attorney wishes to express gratitude to the Examiner for the indication that claims 41-48 are allowable and that claims 21, 33, 35, 36, and 79 would be allowable if amended as recited in the Office Action.

IN CLOSING

Applicant believes all outstanding issues raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 735-6323.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard R. Batt".

Richard R. Batt
Reg. No. 43,485

ArthroCare Corporation
680 Vaqueros Ave.
Sunnyvale, CA 94085-3523
(408) 736-0224